

**THIS DISPOSITION
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THE TTAB**

Hearing:
July 28, 2005

Mailed: November 15, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Topline Corporation

Serial Nos. 778217228 and 78975345

William O. Ferron, Jr. of Seed Intellectual Property Law
Group for The Topline Corporation.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Hohein and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

On February 26, 2003, The Topline Corporation filed an application to register the mark REPORT SEATTLE, in standard character form, on the Principal Register based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods. On February 11, 2004, applicant filed a request to divide the application into two applications. The parent application, Serial No. 78217228, retained goods identified, as amended,

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as "men's, women's and children's apparel, namely, shirts, pants, jeans, sweaters, skirts, dresses, suits, lingerie, shorts, coats, jackets, and swimwear; fashion accessories, namely, hosiery, belts, hats, gloves and scarves." The child application, Serial No. 78975345, is for the same mark, REPORT SEATTLE, for "footwear." Each application includes a claim of applicant's ownership of three registrations.¹

The Trademark Examining Attorney has issued a final refusal to register in each application under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark REPORT COLLECTION, in standard character form, for "clothing and accessories, namely shirts, polos, T-shirts, sweatshirts, sweaters, cardigans, wind resistant jackets, coats, underwear, belts, socks,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

¹ The three claimed registrations on the Principal Register are No. 2169637 for "REPORT:" for "women's shoes," No. 2377891 for "ONE ON 1 BY REPORT:" for "women's and children's fashion shoes sold through shoe stores and shoe departments of department stores," and No. 2681120 for



for "footwear."

² Registration No. 1957041 issued February 20, 1996, to Modextil Inc., in International Class 25; Section 8 & 15 affidavits accepted and acknowledged; renewed. The registration includes a disclaimer of COLLECTION apart from the mark as a whole.

Additionally, the Examining Attorney has issued a final refusal to register in each application under Section 6 of the Trademark Act, 15 U.S.C. 1056, on the ground that the term SEATTLE is geographically descriptive and must be disclaimed because applicant is located in Bellevue, Washington, which is a suburb of Seattle.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. Because the appeals involve common questions of law and fact, we have decided them in a single opinion. We affirm the refusals to register.

Disclaimer Requirement

The Examining Attorney contends that the term SEATTLE is primarily geographically descriptive because it is the name of a place generally known to the public; that Bellevue, Washington, the location of applicant's principal offices, is within the Seattle metropolitan area³; that, applicant's goods come from the area named in the mark and, therefore, a goods/place association is presumed; and that applicant's argument that SEATTLE evokes the feeling and aesthetic of the Pacific Northwest, rather than primarily indicating a geographic location, is not established in the record.

³ The Examining Attorney submitted excerpts from two sources showing that Bellevue, Washington, is located on lake Washington opposite

Applicant contends that the meaning of its entire mark is not primarily geographic; that the significance of SEATTLE in applicant's mark is not geographic; that the fact that applicant's "principal offices are near Seattle does not mandate a finding that a goods/place association should be presumed" (Brief, p. 8); and that prospective consumers will not believe that Seattle is the geographic origin of applicant's identified clothing.

While applicant contends that its mark as a whole is not geographically descriptive, that is not the issue before us. The disclaimer refusal concerns the geographic descriptiveness of the term SEATTLE in the context of the mark as a whole. The test is whether (i) the term in the mark sought to be registered is the name of a place known generally to the public, and whether (ii) the public would make a goods/place association, that is, believe that the goods or services for which the mark is sought to be registered originate in that place. *See, e.g., University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). See also *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001). If the goods do

Seattle; that the two cities are connected by a bridge; and that Bellvue

in fact emanate from the place named in the mark, the goods/place association can be presumed. *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998).

In this case, applicant's principal offices are in Bellevue, Washington. Because Bellevue is a close, connected suburb of Seattle, it is reasonable to view Bellevue as part of the Seattle metropolitan area. Applicant does not dispute that its goods come from this area. There is no question that Seattle is a generally-known geographical location and that, in view of the facts and the relevant case law, we can presume a goods/place association. Applicant has presented absolutely no evidence in support of its contention that, in the context of its mark, the term SEATTLE would have a non-geographic significance, nor is such a conclusion evident. Therefore, we find that the term SEATTLE in applicant's mark, REPORT SEATTLE, is primarily geographically descriptive and that the Examining Attorney's requirement for a disclaimer is appropriate.

Likelihood of Confusion

The Examining Attorney contends that the marks are confusingly similar because both marks contain the identical dominant term, REPORT; that the additional term in the registered mark, COLLECTION, is merely descriptive and has

is a suburb of Seattle. *The Columbia Gazeteer of North America*, 2000.

been disclaimed and the additional term in applicant's mark, SEATTLE, is primarily geographically descriptive; and that the alleged coexistence and lack of actual confusion is not persuasive because the record contains no evidence pertaining to the nature and extent of use by applicant and registrant.⁴ Regarding the goods, the Examining Attorney argues that the parent application herein and the cited registration include identical and related clothing items. Regarding the child application, the Examining Attorney argues that previous decisions have held that the types of apparel in the cited registration and footwear are related; that the purchasers and channels of trade of the respective products are the same; and that evidence submitted by the Examining Attorney in the form of excerpts from Internet websites and third-party registrations supports the conclusion that such goods "are commonly marketed in the same channels of trade through use of a single mark" (Serial No. 78975345 Brief, p. 6).

Applicant contends that its "REPORT marks have coexisted with the cited Registrant's mark in the marketplace for over 11 years without confusion" (Serial No. 78217228 Brief, p. 3); that the marks have coexisted on the register since 1998; that "Applicant's coexisting REPORT

⁴ The Examining Attorney objects to considering arguments based on applicant's other registrations because copies of the registrations were not submitted. This objection is discussed *infra*.

marks do not contain the distinctive term SEATTLE included in the present application, further amplifying the lack of potential confusion between REPORT SEATTLE and REPORT COLLECTION" (*id.*); and that the marks, viewed in their entirety, are different in pronunciation and commercial impression. Regarding its parent application, applicant concedes that "both marks are used in association with clothing," but argues that "there is no *per se* rule that similar marks used for clothing are likely to cause confusion" (Serial No. 78217228 Brief, p. 6).⁵ Regarding its child application, applicant contends that it has prior use of its mark in connection with footwear as well as an incontestable registration for a REPORT mark for footwear.⁶

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d

⁵ Applicant has misstated the "rule," which is that there is no *per se* rule that goods are related simply because the goods are in the same general category, in this case, clothing. To consider whether goods are related, we must consider the record in each case. Then, based on the entire record and all relevant factors, we will determine whether a likelihood of confusion exists.

⁶ With respect to this argument, the Examining Attorney contends that applicant's prior use and registration are irrelevant in this *ex parte* appeal; and, moreover, that the mark and goods in applicant's incontestable registration are different from the mark and goods in this application.

1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this regard, we find that the word REPORT is the dominant feature in the commercial impression created by each of the marks at issue. It is the first word in each mark; it would appear to be an arbitrary term in connection with applicant's and registrant's goods; and the words SEATTLE and COLLECTION in the respective marks are descriptive and, thus, contribute relatively less to the commercial impressions of the respective marks. In terms of appearance, sound, connotation and overall commercial impression, we find that the similarity between the marks that results from the presence of the word REPORT in both marks outweighs the points of dissimilarity between the marks. Viewing the marks in their entirety, we find that they are sufficiently similar that, if used to identify the same or related goods, confusion as to source would be likely.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods recited in

applicant's application vis-à-vis the goods recited in the registration, rather than what the evidence shows the goods actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Several of the items of clothing identified in the parent application are identical to several of the clothing items identified in the cited registrations, i.e., men's shirts, sweaters, coats, jackets⁷ and belts. Thus, there is

⁷ Registrant's "wind resistant jackets" are encompassed by applicant's "jackets."

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no need to consider whether or to what extent the other goods recited in the parent application are related to the goods in the cited registration. If confusion is likely with respect to any of the goods in a class, a refusal of registration must be affirmed. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). Regarding the child application, the following excerpts, submitted by the Examining Attorney, from Internet websites show footwear marketed closely with the various clothing items identified in the cited registration:

www.eisenbergandeisenberg.com - a website offering men's formalwear has a category entitled "shirts, ties, shoes & accessories";

www.studdedesigns.com - a website offering various gem-studded items has a category entitled "shoes/T-shirts";

www.dealcloset.com - a website with a page entitled "Tommy Bahama Catalogue," includes the following text - "The DealCloset staff love Tommy Bahama. They provide top quality casual clothing. Our silk Hawaiian print shirts always get noticed. The catalogue also sells regular shirts, jeans, loose shorts, campshirts, silk/cotton blend polo shirts, and sweatshirts. If you want to look great wearing casual clothing this is absolutely the brand to buy. ... We recently discovered a great source for Tommy Bahama shoes."

The Examining Attorney also submitted copies of eleven third-party registrations, all based on use in commerce, that in each instance include both the men's clothing items identified in the cited registration and "footwear" in connection with the same marks. Moreover, because the

parent application evidences applicant's intent to broaden its line of products from footwear, identified in its existing registrations, to include clothing items, applicant's own intentions are evidence that such items may emanate from the same source and be identified by the same mark. We find that applicant's broadly identified "footwear" in its child application is sufficiently related to the men's clothing items identified in the cited registration that, if identified by confusingly similar marks, confusion as to source is likely.

To the extent that both applicant's and registrant's goods are identical and there are no limitations on the channels of trade or class of purchasers, there are no legally relevant differences in the channels of trade and class of purchasers. *Octocom Systems Inc. v. Houston Computers Services Inc.*, 16 USPQ2d 1783, (Fed Cir. 1990). See also *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989).

Therefore, particularly in view of the substantial similarity in the commercial impressions of applicant's mark, REPORT SEATTLE, and registrant's mark, REPORT COLLECTION, and the fact that the same and related goods, trade channels and class of purchasers are involved in each of the applications herein, the contemporaneous use of the

marks on the identified goods is likely to cause confusion as to the source or sponsorship of such goods.

We are not convinced otherwise by applicant's arguments regarding the coexistence on the Register of its three subsisting registrations and the cited registration.⁸ The marks contain matter not present in this application, and do not include SEATTLE, so they are of little value to our determination. The Board must decide *these* cases now before us on their merits. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Design's application, the PTO's allowance of such prior registrations does not bind the Board or this Court."). See also, *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

With regard to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the alleged contemporaneous use of the marks of applicant and registrant, we note that, not only is there no evidence or allegation of use in either intent-to-use application or in this proceeding, but the absence or presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by

⁸ In view of applicant's claim of ownership of these registrations and the Examining Attorney's acceptance of this claim, the Examining

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registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

Decision: The refusals under Section 6 and Section 2(d) of the Act are both affirmed in each application.

attorney's objection to considering these registrations herein is not well-taken.